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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,762	03/24/2004	Joshua Jenkins	6247P001C	5904

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EXAMINER

NEGRON, ISMAEL

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/808,762

Applicant(s)

JENKINS, JOSHUA

Examiner

Ismael Negron

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-6 is/are rejected.
- 7) ☒ Claim(s) 1, 4 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on August 4, 2005 has been entered. Claims 1 and 3-5 have been amended. Claim 2 has been cancelled. No claim has been added. Claims 1 and 3-6 are still pending in this application, with claims 1 and 5 being independent.

Claim Objections

2. Claim 1 is objected to because of the following informalities: line 11 should read: "including **includes** an attaching pin to couple to a light bar having at least one". Appropriate correction is required.

3. Claim 4 is objected to because of the following informalities: line 2 should read: "of the first and the second light fixture coupling brackets each **being** adaptable to couple to a". Appropriate correction is required.

4. Claim 5 is objected to because of the following informalities: line 8 should read: "and a second tightening handle, wherein said removable gripping device **is**". Appropriate correction is required.

Claim Rejections - 35 USC § 112

First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 2 and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recited the light bar coupling device as including an attaching pin, such pin being for coupling a light bar, however, no such light bar coupling device is disclosed by the description of the drawings. It is noted that it is the light bar bracket which includes the only pin capable of coupling a light bar.

6. The applicant is advised that in comparing the claimed invention with the Prior Art the Examiner assumed the attaching pin to be part of the light bar bracket, as disclosed and shown in Figure 5.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by ROSENTHAL (U.S. Pat. 4,504,888).
8. ROSENTHAL (U.S. Pat. 4,504,888) discloses an apparatus having:
- **a first light fixture coupling brackets (as recited in Claim 1), Figure 16, reference number 91;**
 - **a second light fixture coupling brackets (as recited in Claim 1), Figure 16, reference number 91;**
 - **each light fixture coupling brackets being adapted to removably couple to a frame of a light box (as recited in Claim 1), column 6, lines 13 and 14;**
 - **the light fixture coupling brackets each including a first through-hole (as recited in Claim 1), as seen in Figure 16;**
 - **the light fixture coupling brackets each including a second through-hole (as recited in Claim 1), as evidenced by Figure 2;**
 - **the light fixture coupling brackets being coupled to the frame by a light bar coupling device (as recited in Claim 1), Figure 2, reference number 25;**

- **the light bar coupling device being inserted into the first through-hole of the first and the second light fixture coupling brackets (as recited in Claim 1), as seen in Figure 2;**
- **a first tightening handle (as recited in Claim 1), Figure 2, reference number 15;**
- **a second tightening handle (as recited in Claim 1), Figure 2, reference number ;**
- **each tightening handle being coupled to a light fixture coupling bracket through the second through-hole (as recited in Claim 1), as seen in Figure 16; and**
- **the light bar coupling device including an attaching pin to couple a light bar (as recited in Claim 1), Figure 2, reference number 19.**

9. Regarding the claimed light fixture coupling brackets being adaptable to couple to a removably and adjustable gripping device, and all the structural limitations related to such gripping device (as recited in claims 1 and 3), the applicant is advised that it has been held by the courts that the recitation that an element is adapted to perform a function or serve in a given application is not a positive limitation, but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. In this case, the claim language is not even defining the light fixture coupling brackets as being adapted to couple the gripping device, but merely the capacity of being adapted to couple such device. The patented light fixture coupling brackets of ROSENTHAL were considered inherently

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capable of being adapted to couple, not only the recited gripping device, but any other gripping device.

10. Regarding the claimed light fixture coupling brackets being adaptable to couple to the recited light bar bracket (as recited in Claim 4), the applicant is further advised that the patented light fixture coupling brackets of ROSENTHAL were considered inherently capable of being adapted to couple such light bar bracket. See previous Section 7.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over FINN et al. (U.S. Pat. 6,106,125) and ROSENTHAL (U.S. Pat. 4,504,888).

12. FINN et al. discloses an illumination device having:

- **a light box (as recited in Claim 5), Figure 2, reference number 1;**
- **a light bar (as recited in Claim 5), Figure 2, reference number 14;**
- **at least one removable adjustable gripping device (as recited in Claim 5), Figure 1, reference number 83;**

- **the brackets being adapted to couple to the gripping device (as recited in Claim 5), column 4, lines 55-59;**
- **the light box having a plurality of expansion rods (as recited in Claim 5), Figure 7, reference number 14;**
- **the light box having first and second frames (as recited in Claim 5), Figure 7, reference number 22; and**
- **the expansion rods being coupled to the frames (as recited in Claim 5), column 3, lines 14-17.**

13. FINN et al. discloses all the limitations of the claims, except:

- the gripping device being coupled with the first and second handles (as recited in Claim 5);
- the adjustable gripping device including a gripping pin (as recited in Claim 5);
- the gripping pin being coupled to a rear portion of the gripping device (as recited in Claim 5);
- the gripping pin is substantially centered on the rear portion of the gripping device (as recited in Claim 5); and
- the gripping pin being removable from the gripping device (as recited in Claim 5).

14. ROSENTHAL discloses an illumination device having:

- **a light box (as recited in Claim 5), Figure 2, reference number 10;**

- **a light bar (as recited in Claim 5), Figure 2, reference number 12;**
- **a plurality of light fixture coupling brackets (as recited in Claim 1), Figure 2, support portion of reference number 15;**
- **first and second tightening handles (as recited in Claim 5), Figure 16, reference number 99;**
- **at least one light socket (as recited in Claim 5), Figure 4, reference number 20;**
- **the light socket being mounted to the light bar (as recited in Claim 5), column 3, lines 51-53;**
- **an adjustable gripping device (as recited in Claim 5), Figure 2, reference number 11;**
- **the gripping device being coupled with the first and second handles (as recited in Claim 5), as seen in Figure 2;**
- **the brackets being adapted to couple to the gripping device (as recited in Claim 5), as seen in Figure 2;**
- **the adjustable gripping device including a gripping pin (as recited in Claim 5) Figure 2, reference number 16;**
- **the gripping pin being coupled to a rear portion of the gripping device (as recited in Claim 5), as seen in Figure 2;**
- **the gripping pin being substantially centered on the rear portion of the gripping device (as recited in Claim 5), as seen in Figure 2; and**

- **the gripping pin being removable from the gripping device (as recited in Claim 5), column 3, line 42.**

15. It would have being obvious to one of ordinary skill in the art at the time the invention was made to use the adjustable gripping device of ROSENTHAL as the support of the light box of FINN et al. to enable the light box to be easily aimed in any desired direction, as per the teachings of ROSENTHAL (column 3, lines 39-45).

16. Regarding the light bar including a socket (as recited in Claim 5) or at least one light set attaching pin, it would have been obvious matter of design choice to use the claimed socket and/or light set attaching pin in the light bar of FINN et al. instead of the disclosed C-Clamp structure, since the applicant has not disclosed that using specifically a socket (as recited in Claim 5) or a light set attaching pin solves any problem or is for a particular reason. It appears that the claimed invention would perform equally well with the C-Clamp structure of FINN et al..

Response to Arguments

17. Applicant's arguments filed August 4, 2005 have been fully considered but they are not persuasive.

18. Applicant's arguments with respect to claims 1 and 3-6 have been considered but are moot in view of the new ground(s) of rejection. However, to further clarify the

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issues, the Examiner wishes to discuss the language of Claim 1 and the subject matter defined by such language. Claim language will be presented in **bold underlined italics** immediately followed by comments enclosed in brackets ([]).

Claim 1 - **An apparatus comprising: a first and a second light fixture coupling brackets** [this is the first structural limitation presented by the claim, referring to the elements designated by reference number 15 in Figure 5] **each adapted to removably couple to a frame of a light box** [this limitation merely recites the capability of the coupling brackets of being coupled to the frame of a light box, such recitation being practically devoid of patentable weight since almost anything could be coupled to almost anything] Figure 5, reference number 110], **the first and the second light fixture coupling brackets each including a first and a second through-hole** [it is noted that no "through-hole" is reference by the drawings and only the second one is shown, see Figure 7] **and coupled to the frame** [while the coupling brackets are recited as coupled to the frame, the frame is not part of the claimed invention, but merely the external structure to which the claimed coupling brackets are coupled] **by a light bar coupling device** [this refers to the elements designated by reference number 190 in Figure 5, and was considered the second structural limitation presented by the claim] **inserted into the first through-hole of the first and the second light fixture coupling brackets** [this was considered a structural limitation, disclosed in Figure 5],

a first and second tightening handle [this refers to the elements designated by reference number 145 in Figure 5, and was considered a structural limitation] **each coupled to a light fixture coupling bracket through the second through-hole of the first and the second light fixture coupling brackets** [this was considered a structural limitation, disclosed in Figure 5];

wherein said light bar coupling device including an attaching pin [this recitation was considered new matter as the specification and drawings show the attaching as part of the light bar bracket 160, not of the coupling device 190; see Figure 7, reference number 165] **to couple a light bar** [this recitation was considered related to the intended use of the attaching pin] **having at least one socket adapted (not shown) to accept the attaching pin within the at least one socket (as evidenced by Figure 8)** [this recitations were considered as having no patentable weight as they are directed to the light bar, such light bar not being part of the invention], **said plurality of light fixture coupling brackets adaptable to couple to a removably and adjustable gripping device** [as previously stated, the use of the word “adaptable” merely present the capability of the coupling brackets of being adapted to be coupled to the gripping device] **including a gripping pin, said gripping device is rotatably adjusted around said light box, said gripping device coupled with the first and the second tightening handles and the first and the second light fixture coupling brackets** [this recitations were considered as having no patentable weight as

they are directed to the gripping device, such device not being part of the invention].

19. In addition, the applicant is respectfully advised that while the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 70 USPQ2d 1827 (Fed. Cir. May 13, 2004). The applicant is also advised that, that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

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21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.


Inr

September 9, 2005


THOMAS M. SEMBER
PRIMARY EXAMINER